

REMARKS/ARGUMENTS

I. PRIOR ART MATTERS

- A. The Office Action rejected claims 1-22 under 35 USC 103(a) as being unpatentable over Lu. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.¹ If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.²

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.³

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

The reference does not teach or suggest all the claim limitations.

As to claim 1, Lu does not teach or suggest:

storing in a memory a first data structure encoding a plurality of words
and corresponding abbreviations;

storing in a memory a second data structure encoding a plurality of
abbreviations and corresponding words;

¹ MPEP Sec. 2142.

² Id.

³Id. (emphasis supplied)

selecting an abbreviation in the text to be converted to a word and converting the abbreviation to a word using the second data structure.

The Office Action is incorrect in stating that Lu discloses selecting an abbreviation in the text to be converted to a word and converting the abbreviation to a word. Lu only discloses converting a token (that has been created from a Long Case Name) into an abbreviated version of the Long Case Name, i.e., to a "short case name" (SCN). That is, if the Examiner identifies Lu's Long Case Name (LCN) with the claimed "word" and the Short Case Name (SCN) with the claimed "abbreviation", there is no disclosure in Lu of converting an SCN ("abbreviation") to an LCN ("word"). Lu only works in the direction of converting a "word" to an "abbreviation." Furthermore, the token that is converted to an SCN is not in the text that is being acted upon.

In addition, the Examiner is taking Official Notice that:

It would have been obvious to an ordinary skill at the time of the invention was made to have modified Lu to include storing in the memory a first data encoding a plurality of words and corresponding abbreviations and a second data structure encoding a plurality of abbreviations and corresponding words for the following reason. Lu teaching of lists and phrases and corresponding abbreviations suggests storing in the memory two different data structures for two different lists of words and abbreviations. Also, it was well known in the art that once said lists are in the memory, the lists can be displayed for manipulating including selecting an item in the list by a user.

This is impermissible. As noted above, "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." The Examiner has not shown where the prior art teaches or suggests making the claimed combination or a reasonable expectation of success. Finally, the Examiner has not applied the test of *Graham v. John Deere Co.*⁴ The

⁴ 383 U.S. 1 (1966)

MPEP requires the Examiner to do so.⁵ However, the Examiner has made no finding of the level of ordinary skill in the art.⁶

Claim 1 is therefore allowable.

Claims 2-14 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

The Office Action rejected claim 15 under the same rationale as claim 1. Because claim 1 is allowable, claim 15 is also allowable.

Claim 16 contains additional elements or limitations beyond allowable claim 1 and is also allowable.

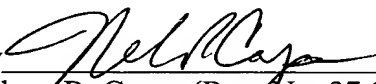
The Office Action rejected claim 17 under the same rationale. Therefore, claim 17 is also allowable.

Claims 18-22 contain additional elements or limitations beyond allowable claim 17 and are also allowable.

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Respectfully submitted,

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⁵ MPEP § 2141

⁶ MPEP § 2141.03